

REMARKS

Claims 1-16, 24, 28-33 and 55 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-16, 24 and 28-33 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Assisi (U.S. Patent No. 5,696,488) in view of Lake (U.S. Patent No. 6,471,129). Claim 55 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Assisi (U.S. Patent No. 5,696,488) as modified by Lake as applied to Claim 1 above, and further in view of Downing (U.S. Patent No. 4,689,757). Applicant respectfully traverses these rejections for at least the following reasons.

Interview

Applicant wishes to express appreciation for the Interview granted with Examiner on October 8, 2003. Applicant below summarizes the Interview, in conjunction with Applicant's Remarks.

Claim Rejections Pursuant to 35 U.S.C. 112, Second Paragraph

Claims 1-16, 24, 28-33 and 55 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

35 U.S.C. 112, second paragraph, states:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The present office action rejects Claim 1, specifically referencing the portion of the claim which states “the memory device is externally connectionless for at least one of data and power.” The present office action represents that this phrase is unclear to the Examiner and sets setting forth two questions: “is application referring the data as memorial information stored in the memory device?” and “how can data be externally connectionless to the device?”. Similarly, the present office action rejects Claims 9, 24, 28 and 55. Further, Claims 2 – 8, 10 – 16 and 29 – 33 are referenced as vague and indefinite as depending from the claims rejected above.

Applicant has amended Claim 1 to more distinctly point out and claim the present invention. In this regard, Applicant has amended Claim 1 to include “physically contactless”, as opposed to “connectionless”. Applicant respectfully submits that, in addition to more distinctly pointing out and claiming what Applicant regards as the invention, this change also renders the rejection in the present office action overcome. Applicant thus respectfully submits that Amended Claim 1 satisfies 35 U.S.C. § 112.

Applicant has also amended Claim 1 to remove the language “one of”, prior to “data and power” because of the Interview, and any ambiguity this language might arguably create. In order to expedite prosecution, Applicant has amended

Claim 1, thereby removing the “at least” language, leaving “wherein the memory device is externally physically contactless for at least data and power”.

Applicant has similarly amended Claims 9, 24, 28, and 55, and further respectfully submits that the rejection based on 35 U.S.C. § 112 has been overcome with respect to those independent claims.

Claim Rejections Pursuant to 35 U.S.C. §103

Claims 1-16, 24 and 28-33 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Assisi (U.S. Patent No. 5,696,488) in view of Lake (U.S. Patent No. 6,471,129). Claim 55 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Assisi (U.S. Patent No. 5,696,488) as modified by Lake as applied to Claim 1 above, and further in view of Downing (U.S. Patent No. 4,689,757). Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. §103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negated by the manner in which the invention was made.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *MPEP 706.02(j)*.

A. **Claims 1-16, 24 and 28-33**

Claims 1-16, 24 and 28-33 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Assisi (U.S. Patent No. 5,696,488) in view of Lake (U.S. Patent No. 6,471,129). Applicant respectfully traverses these rejections for at least the following reasons.

Amended Claim 1 states, in relevant part,

a portable memory reading device holdable by one of the public users, separate from the memory device, that retrieves the memorial information directly from the memory device via a non-permanent proximity link when positioned at the memory device location, and that communicates the memorial information to at least one of the public users located at the cemetery location

and

wherein said communication of the memorial information to at least one of the public users located at the cemetery location sequentially follows and is substantially temporally commensurate with said retrieval of the memorial information directly from the memory device. [Emphasis Added].

Examiner has rejected Claim 1, asserting, at least in part, “a portable memory reading device 3, 11 ... that retrieves the memorial information directly from the memory device of the cemetery location when it is positioned at the cemetery location (i.e., wireless communication carried out when the portable memory reading device is brought into the vicinity of the memory device 2...).” Applicant respectfully submits that in Applicant’s invention, as claimed in amended Claim 1, includes that the “portable memory reading device ... communicates the memorial information to” a user while the user is “located at the cemetery location.” In Assisi, on the other hand, “[t]he information stored in the communications apparatus 3 may be later reproduced ... or ... may be directly processed.” Assisi Col. 2, lines 31-33, [Emphasis Added]. Assisi thus does not teach real time, or quasi real time, i.e., “temporally commensurate”, presentation of the information. Further, Assisi teaches “[t]he communication device includes a recording medium for intermediate storage of the information called up from the storage device. This information may, for example, be displayed and/or printed out, or made audible as sound at home by means of appropriate devices.” Assisi Col. 1, lines 57-62, [Emphasis Added]. Assisi’s teachings do not include, as

part of the communication device, the capability of presentation through a display or speaker, for example.

Inapposite, the present invention employs a “portable memory reading device ... that communicates the memorial information to at least one of the public users located at the cemetery location” and “wherein said communication of the memorial information to at least one of the public users located at the cemetery location sequentially follows and is substantially temporally commensurate with said retrieval of the memorial information directly from the memory device.” *Claim 1*. Applicant submits that Applicant’s invention employs a portable memory reading device to communicate the memorial information to the user located at the cemetery location, i.e., the communication and retrieval both occur while the user is located at the cemetery location, and without using other means to communicate the information. Specifically, Applicant’s specification recites a “portable memory reading device 5 ... that has the ability to read, receive, and/or display all or a portion of the information stored on memory devices 2B-3B.” *Specification at page 6, lines 6-8.*

At least this shortcoming in the teaching of Assisi, a deficiency not filled by Lake, nor asserted by the Examiner to be filled, causes Assisi to fail to render amended Claim 1 unpatentable. The present Office Action identifies Lake for the proposition that the memory device is externally connectionless for at least one of data and power, but Lake does not teach, nor is Lake asserted to teach the shortcoming in the teaching of Assisi identified hereinabove.

Assisi in view of Lake thus fails to teach, at least, a portable memory reading device that communicates the memorial information to a user while the user is located at the cemetery location, and thus Assisi in view of Lake does not render Claim 1 unpatentable. See *MPEP 2131*. Consequently, Applicant traverses the 35 U.S.C. §103(a) rejection of Claim 1, deems it overcome, and respectfully requests removal of the rejection. In addition, Applicant submits that independent Claim 1 is in a condition for allowance.

Applicant further submits that Assisi in view of Lake fails to teach, and therefore anticipate or render unpatentable, Claims 2-8 because of these claims ultimate dependence on patentably distinct base Claim 1. Applicant submits that each of Claims 2-8 are similarly in a condition for allowance.

Independent Claims 9 and 28 similarly recite that the portable memory reading device communicates the information to a user located at the particular location. In this regard, Applicant respectfully submits that Claims 9 and 28 are not rendered unpatentable by Assisi in view of Lake, at least for the reasons set forth hereinabove with respect to Claim 1. Amended independent Claims 9, 24 and 28 similarly recite that the communication of the memorial information to at least one of the public users located at the cemetery location sequentially follows and is substantially temporally commensurate with said retrieval of the memorial information directly from the memory device. In this regard, Applicant respectfully submits that Claims 9, 24 and 28 are not rendered unpatentable by Assisi in view of Lake, at least for the reasons set forth hereinabove with respect to Claim 1. Consequently, Applicant traverses the 35 U.S.C. §103(a) rejections of Claims 9,

24 and 28, deems them overcome, and respectfully requests removal of these rejections. In addition, Applicant submits that independent Claims 9, 24 and 28 are in a condition for allowance.

Applicant further submits that Assisi in view of Lake fails to teach, and therefore anticipate or render unpatentable, Claims 10-16 and 29-33 because of these claims' ultimate dependence on patentably distinct base Claims 9 and 28, respectively. Applicant thus submits that each of Claims 10-16 and 29-33 are similarly in a condition for allowance.

B. Claim 55

Claim 55 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Assisi (U.S. Patent No. 5,696,488), as modified by Lake as applied to Claim 1 above, and further in view of Downing (U.S. Patent No. 4,689,757). Applicant respectfully traverses these rejections for at least the following reasons.

Amended Claim 55 states in relevant part

wherein said communication of the memorial information to at least one of the public users located at the cemetery location sequentially follows and is substantially temporally commensurate with said retrieval of the memorial information directly from the memory device.

As set forth hereinabove with respect to amended Claim 1, at least this portion of amended Claim 55 overcomes the rejection of the present Office Action based on Assisi and Lake. This deficiency in the teaching of Assisi, while not be cured by Lake, is similarly not cured, nor even asserted to be so, by Downing. Consequently, Applicant traverses the 35 U.S.C. §103(a) rejection of Claim 55, deems it overcome, and respectfully requests removal of the rejection. In addition, Applicant submits that independent Claim 55 is in a condition for allowance.

C. Motivation and Reasonable Expectation of Success for Combining References for the § 103 Rejection

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on an applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). It is improper to combine references where the references teach away from their combination. *In re Grasselli* 713 F.2d 731 (Fed. Cir. 1983). More specifically, MPEP § 2143.01 states:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d

1430, 1433-34 (*Fed. Cir.* 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (*Fed. Cir.* 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (*Fed. Cir.* 1992).

Further, MPEP 2141.02

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (*Fed. Cir.* 1983), cert. denied, 469 U.S. 851 (1984).

Applicant respectfully submits that the combination of Assisi and Lake, and the further combination of Assisi, Lake and Downing, both are impermissible combinations of references. In particular, Lake teaches the use of externally contactless transfer of data. This is in direct contradiction to the teachings found in Downing, wherein it is specifically set forth that hardwiring or conventional connectors, i.e. permanent cabled connections, are utilized.



Conclusion

Applicant respectfully requests reconsideration of the present Application in light of the reasons set forth herein, and a Notice of Allowance for all pending claims is earnestly solicited.

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Respectfully Submitted,

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Todd A. Norton
TODD A. NORTON
Registration No. 48,636
THOMAS J. MCWILLIAMS
Registration No. 44,930
2500 One Liberty Place
1650 Market Street
Philadelphia, PA 19103
(215) 851-8100
Attorneys for Applicant